

REMARKS

I. PRELIMINARY REMARKS

Claims 23, 24 and 28 have been amended. No claims have been added or canceled. Claims 24-34 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicant notes with appreciation that claims 29-34 have been allowed and that the Office Action indicated that claims 24, 25 and 28 are directed to patentable subject matter. As claims 24 and 28 have been re-written in independent form, applicant respectfully submits that claims 24, 25 (which depends from 24) and 28 are in condition for allowance.

II. PRIOR ART REJECTION

A. The Rejection

Claims 23, 26 and 27 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,873,855 to Eggers ("the Eggers patent"). The rejection under 35 U.S.C. § 102 is respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

B. Discussion Concerning Claims 23, 26 and 27

Independent claim 23 calls for a combination of method steps comprising "positioning an electrode on the epicardial surface of a ventricle" and "transmitting energy from the electrode, through the epicardial surface and into the ventricular wall to create a lesion within the ventricular wall ***without creating a channel in the***

ventricular wall.”¹ The combinations defined by claims 26 and 27 include, *inter alia*, the steps recited in claim 23.

The Eggers patent fails to teach or suggest such combinations. For example, the Eggers patent is directed to transmyocardial revascularization (“TMR”). As noted in the Eggers patent at column 21, lines 40-45 and column 22, lines 41-54, the Eggers TMR procedures create channels that extend completely, or partially, through the associated heart wall.

As the Eggers patent fails to teach or suggest each and every step in the combination recited in independent claim 23, applicant respectfully submits that the rejection of claims 23, 26 and 27 under 35 U.S.C. § 102 should be withdrawn.

III. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant’s undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such

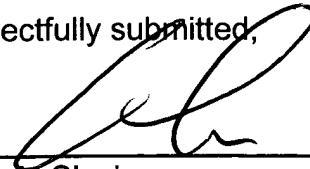
¹ See the present specification at, for example, page 1, line 26 to page 2, line 6; page 3, line 30 to page 4, line 2; and page 7, lines 2-4.

fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

12/3/05
Date

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